REMARKS

This is responsive to the outstanding Office Action issued July 13, 2004. Claims 1 to 19 and 40 to 50 are pending. This Amendment and Response amends claims 40 and 45, and cancels without prejudice claims 20 to 39 and claims 51 to 56. Claims 1-19, 41-44, and 46-50 are original. Claims 1 -3 and 5-56 have been rejected. The Office Action Summary lists claim 4 as rejected but there is no explanation of a rejection of record of this claim.

Rejection Under 35 U.S.C. § 112

Claims 40, 45 and 51 are rejected under 35 U.S.C. § 112, paragraph two as having insufficient antecedent basis for the limitation "the restraint". With the above amendments, these claims comply with all requirements of 35 U.S.C. § 112 and this rejection should be withdrawn.

Rejection Under 35 U.S.C. § 102

Claims 1 -3, 5-13, 16-22, 24-32 and 35-56 are rejected under 35 U.S.C. § 102(b) as being anticipated by GB-2020557 to Rüsch ("Rüsch"). Claims 20 – 22, 24 – 32 and 35 – 39 have been canceled. Applicants traverse this rejection as to pending claims 1 – 3, 5 – 13, 16 – 19 and 40 – 50. It is elementary that a sustainable rejection under 35 U.S.C. § 102(b) requires the presence in a single reference of all elements recited in the rejected claim.

Rüsch does not show or suggest a "guidewire", while all of the present claims require a "guidewire". A feature of the present invention is that the filter element is carried by a guidewire. In the context of the present application, the term guidewire is properly construed to mean an elongate component that can be used in combination with a number of other medical devices, such as balloon catheters and atherectomy devices. In particular, these various other medical

devices generally include a central or axial opening able to receive the guidewire, such that the medical device many be tracked along the guidewire from its free end towards its end within the patient's body, the guidewire acting as a guide for positioning the medical device. The guidewire may also act as a guide for the retraction and removal of the medical device after it has been used. See the present application at page 39, lines 14-21; page 43, lines 5-13; page 43, line 27 – page 45, line 28; *inter alia*. This construction of the term "guidewire" is consistent with the meaning understood by those of skill in the art. See, for example, the definition of guidewire in White, et al., *A Color Atlas of Endovascular Surgery*, J. B. Lippincott Co., Philadelphia, 1990, pages 26-27, attached hereto:

> In general, guidewires are used to find and secure a pathway through the artery and the stenotic lesion. They pass well into the channel and act as a guide to the subsequent passage of therapeutic devices.

Rüsch does not disclose a guidewire. Rüsch discloses a medical instrument having a controlling cable 4 that functions as a controlling or positioning element (page 2, 48-57). The Rüsch controlling element or cable 4 cannot be a guidewire, because an operating element 5 is firmly attached to the controlling element 4 proximal end (Rüsch, page 4, lines 50-54), so that the operating element 5 may withstand pulling action to retract the controlling element 4 proximally (Rüsch, page 4, lines 92-99). In addition, a screw 3 protrudes radially. These structures preclude the passage over cable 4 of other medical devices, such as balloon catheters and atherectomy devices.

Accordingly, this rejection of claims 1 -3, 5-13, 16-19, and 40-50 is unsupportable and must be withdrawn.

Rejection Under 35 U.S.C. § 103

Claims 14, 15, 23, 33 and 34 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Rüsch. This rejection is understood as including the rejection of claim 4, inasmuch as claims 15, 23 and 34, also reciting nitinol for the filter element, are presently rejected. The rejection is moot as to claims 23, 33 and 34 which have been canceled. This rejection does not set forth a sustainable finding of obviousness for pending claims 4, 14 and 15 and is traversed.

The remarks concerning Rüsch in regard to the previous rejection of claim 1 from which these claims depend are repeated here as equally pertinent. Rüsch does not disclose or suggest a "guidewire" as required by claim 1. These claims include that limitation plus others and therefore distinguish over Rüsch.

Accordingly, this rejection of claims 4, 14, and 15 is unsupportable and must be withdrawn.

CONCLUSION

In view of Applicants' present amendments to the claims and the remarks above, all of the pending claims are submitted to be in condition for allowance.

Amendment and Response
Applicants: Rudy Mazzocchi et al.
Serial No.: 10/051,591

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If any additional fees are due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 16-2312. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our deposit account.

Respectfully submitted,

Date: 10/11/04

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